

### REMARKS

Claims 144-159 are presently pending in the application and were deemed allowable in the Advisory Office Action dated March 17, 2009. However, the May 14, 2009 Office Action withdrew the allowability of claims 144-159 and raised a new issue under 35 U.S.C. §103(a). Claims 1-143 and 160-192 have been previously canceled in a good faith effort to put this application in condition for allowance. Claim 144 has been amended. Claims 145-159 depend from independent claim 144 and were previously rejoined.

#### I. REJECTIONS UNDER 35 U.S.C. §103(a) ARE TREATED

The May 14, 2009 Office Action raised an issue under §103(a) with respect to claims 144-459. Specifically, the Office Action stated that claims 144-159 are unpatentable over U.S. Patent No. 5,947,965 (Bryan) (hereinafter referred to as the "Bryan reference") in view of U.S. Patent No. 6,416,515 (Wagner) (hereinafter referred to as the "Wagner reference"). For the reasons that follow, Applicant respectfully traverses the rejection based on the law and facts discussed below.

With respect to independent claim 144, the Office Action stated that the Bryan reference "discloses the claimed invention except for the tapered interface comprising a female threaded portion." That statement simplifies the features claimed in independent claim 144 too far. Referring to Figures 2A, 2B, and 3A of Bryan, the bolt head 56 of bone screw 50 does not include a "tapered external portion" with "a female-threaded recess formed

therein," as is required by Claim 144. In other words, the bone screw 50 of Bryan is not configured to receive another screw to attach C-clamp 60 to bone screw 50. In contrast, the present application teaches a fastener 90 to fasten C-clamp 60 to bone screw 50 (See Figure 2 of the present application).

None of the cited references include the feature of a "fastening member having a male-tapered external portion that tapers outwardly in a proximal-to-distal direction, said male-tapered external portion having a female-threaded recess formed therein."

The Office Action refers to Figure 11 and col. 7, line 50 - col. 8, line 46 of Wagner as teaching a "tapered connection locked together via a female threaded portion." As an initial matter, Applicant notes that col. 7, line 50 - col. 8, line 46 of Wagner refers to Figures 5 and 6, not Figure 11. However, the embodiments of Figures 5 and 6 and that of Figure 11 appear to have similar operational characteristics (i.e., each embodiment uses tapered surfaces to "pinch" a rod to form a frictional interference fit).

Applicant notes that Figure 11 teaches that arms 72 and 74 of connector 16 are tapered. However, the connector 16 taught in Figure 11 of Wagner does not teach or show that the receiving end 54 of connector 16 has "a female-threaded recess formed therein" as is required by Claim 144 (See Figure 2 of the present application, labels 58 and 59). Moreover, the tapered portion of connector 16

in Wagner tapers *inwardly* (instead of *outwardly*), in a proximal-to-distal direction, in contrast to the requirement of Claim 144.

Applicant further notes that the functional locking mechanisms of the present application and Wagner are completely different from one another. For example, tapered arms 72 and 74 of connector 16 close and pinch rod 12 to form an *interference fit*, (as described in Col. 7, line 58 of Wagner) by applying tensile force to connector 16 via faster 18 (a nut) to draw connector 16 down into the tapered recess of spacer 114. In contrast and referring to Figure 2 of the present application, set screw 90 is used to attach C-clamp 60 onto pedicle screw 60 forming a *taper lock* (not an interference fit) between C-clamp 60 and pedicle screw 60. The interference fit taught and required by Wagner is a teaching away of the clamping, compression lock of the present application (See paragraph 0054 of Applicant's published Application) and the structural combination of Claim 144 used to accomplish said clamping, compression lock.

For at least the reasons stated above, the combination of Bryan and Wagner fail to teach each and every element of Claim 144, including: a "fastening member having a male-tapered external portion that tapers outwardly in a proximal-to-distal direction, said male-tapered external portion having a female-threaded recess formed therein." Further, Wagner can not be combined with Bryan to make the claimed combination of Claim 144 obvious to try, because Wagner requires the aforementioned taper lock (as described in Col.

7, line 58 of Wagner). Accordingly, the combination of Bryan and Wagner can not support an obviousness rejection of Claim 144 and Applicant respectfully requests withdrawal of this rejection for at least these reasons.

Further, clamp 60 of Bryan (See Figure 2B) fails to disclose or make any suggestion or hint to a clamp (or any other connecting member) having a "female-tapered through-passage," as required by Claim 144 for mating with the "male-tapered external portion."

However, in order to expedite prosecution, Applicant has further amended Claim 144 to recite: "a fastener having a head portion and a male shaft portion, wherein the outer surface of the shaft portion is threaded." Applicant notes that neither Bryan nor Wagner include "a fastener having a head portion and a male shaft portion, wherein the outer surface of the shaft portion is threaded...to thereby enable the fastener to pass through said second through-passage and into said female-threaded recess," as is required by amended Claim 144. Thus, Applicant respectfully requests withdrawal of the rejection under 103(a) for this reason, in addition to the other reasons discussed above.

Claims 145-159 depend either directly or indirectly from independent claim 144 and are thus patentably distinct for at least the same reasons discussed above with reference to amended Claim 144. Therefore, Applicant respectfully requests withdrawal of the rejection under 103(a) as to dependent Claims 145-159.

## II. CONCLUSION

In view of the foregoing, applicant believes that claims 144-159 are all allowable and the same is respectfully requested. If any impediment to the allowance of these claims remains after entry of this Amendment, and such impediment could be alleviated during a telephone interview, the Examiner is invited to initiate the same. The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0836.

DATED this 14<sup>th</sup> day of August, 2009.

Respectfully submitted,

A handwritten signature in cursive script, reading "Karl R. Cannon", written over a horizontal line.

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